Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARK T. GROSS

Appeal No. 2004-0434
Application No. 09/836,686

ON BRIEF

Before BARRETT, DIXON, and MACDONALD, ***Administrative Patent Judges***.

MACDONALD, ***Administrative Patent Judge***.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 10-16 and 23-25. Claims 17, 21, and 22 have been indicated as allowable; and claims 1-9, 18-20, and 26-30 have been canceled. See paper number 7, dated September 4, 2002, which indicates the amendment filed August 23, 2002, will be entered upon the filing of this appeal.[1]

[1] Although we are treating it as such for the purposes of this appeal, the August 23, 2002, amendment has not yet been formally entered.

Invention

Appellant's invention relates to controlling the sharing of files by portable devices, and, more particularly, to controlling the sharing of music files by portable music players. A host system transfers at least one file to a first portable device. Along with the file, the host system transmits a transfer count associated with the file. The transfer count indicates the number of times that the first portable device may transfer the received file to other devices. Appellant's specification at page 1, lines 3-4, and page 5, line 24, to page 6, line 3.

Claim 10 is representative of the claimed invention and is reproduced as follows:

10. A method, comprising:

selecting at least one music file from a first portable device to transfer to a second portable device;

transferring the music file to the second portable device; and

transmitting a preselected transfer count to the second portable device, wherein the preselected transfer count is indicative of the number of times the second portable device may transfer the music file to one or more devices.

References

The references relied on by the Examiner are as follows:

Abecassis	6,192,340	Feb. 20, 2001 (Filed Oct. 19, 1999)
Berstis et al. (Berstis)	6,282,653	Aug. 28, 2001 (Filed May 15, 1998)

Rejections At Issue

Claims 10-16 and 23-25 stand rejected under 35 U.S.C. § 103 as being obvious over the combination of Abecassis and Berstis.

Throughout our opinion, we make references to the Appellant's briefs, and to the Examiner's Answer for the respective details thereof.[2]

OPINION

With full consideration being given to the subject matter on appeal, the Examiner's rejections and the arguments of the Appellant and the Examiner, for the reasons stated ***infra***, we affirm the Examiner's rejection of claims 10-16 and 23-24 under 35 U.S.C. § 103, and we reverse the Examiner's rejection of claim 25 under 35 U.S.C. § 103.

Appellant has indicated that for purposes of this appeal, the claims stand or fall together in three groupings:

Claims 10-16 as Group I;

Claims 23-24 as Group II; and

Claim 25 as Group III.

See page 10 of the brief. Furthermore, Appellant argues each group of claims separately and explains why the claims of each

[2] Appellant filed an appeal brief on November 25, 2002. Appellant filed a reply brief on September 2, 2003. The Examiner mailed out an Examiner's Answer on July 16, 2003.

group are believed to be separately patentable. See pages 10-13 of the brief and pages 1-3 of the reply brief. Appellant has fully met the requirements of 37 CFR § 1.192 (c)(7) (July 1, 2002) as amended at 62 Fed. Reg. 53169 (October 10, 1997), which was controlling at the time of Appellant's filing of the brief. 37 CFR § 1.192 (c)(7) states:

> *Grouping of claims.* For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and, in the argument under paragraph (c)(8) of this section, appellant explains why the claims of the group are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable.

We will, thereby, consider Appellant's claims as standing or falling together in the three groups noted above, and we will treat:

Claim 10 as a representative claim of Group I;

Claim 23 as a representative claim of Group II; and

Claim 25 as a representative claim of Group III.

If the brief fails to meet either requirement, the Board is free to select a single claim from each group and to decide the appeal of that rejection based solely on the selected representative

claim. ***In re McDaniel***, 293 F.3d 1379, 1383, 63 USPQ2d 1462, 1465 (Fed. Cir. 2002). ***See also In re Watts***, 354 F.3d 1362, 1368, 69 USPQ2d 1453, 1457 (Fed. Cir. 2004).

I. Whether the Rejection of Claims 10-16 Under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 10-17. Accordingly, we affirm.

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a ***prima facie*** case of obviousness. ***In re Oetiker***, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). ***See also In re Piasecki***, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The Examiner can satisfy this burden by showing that some objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art suggests the claimed subject matter. ***In re Fine***, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the Appellant. ***Oetiker***, 977 F.2d at 1445, 24 USPQ2d at 1444. ***See also Piasecki***, 745 F.2d at 1472, 223 USPQ at 788.

An obviousness analysis commences with a review and consideration of all the pertinent evidence and arguments. "In reviewing the [E]xaminer's decision on appeal, the Board must necessarily weigh all of the evidence and argument." ***Oetiker***, 977 F.2d at 1445, 24 USPQ2d at 1444. "[T]he Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion." ***In re Lee***, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

With respect to independent claim 10, Appellant argues at page 11 of the brief, "Berstis does not teach or suggest 'transmitting a preselected transfer count' to a second portable device, nor that such a count is 'indicative of the number of times the second portable device may transfer the music file to one or more devices' as recited in claim 10." Appellant then points out that instead, "Berstis teaches a system in which a count is created that indicates the number of times that a device can transfer a file to one or more target devices." Appellant then argues, "there is no teaching or suggestion to send a transfer count from a first portable device to a second portable device."

To determine whether claim 10 would have been obvious, we must first determine the scope of the claim. Appellant's

specification shows a system at figures 1, 3, and 6, with portable devices for transferring files. Appellant argues that "portable device" should be narrowly defined so as to preclude Abecassis' multimedia player of his figure 1 and Berstis' computers, servers, and components (items 10, 20, 26a, 26b, 26c, 40, 24, 26, and 44) in Berstis' figures 1, 3, and 4 from being "portable devices."

Our reviewing court states in ***In re Zletz***, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) that "claims must be interpreted as broadly as their terms reasonably allow." Our reviewing court further states, "[t]he terms used in the claims bear a 'heavy presumption' that they mean what they say and have the ordinary meaning that would be attributed to those words by persons skilled in the relevant art." ***Texas Digital Sys. Inc v. Telegenix Inc.***, 308 F.3d 1193, 1202, 64 USPQ2d 1812, 1817 (Fed. Cir. 2002), ***cert. denied***, 538 U.S. 1058 (2003).

Upon our review of Appellant's specification, we fail to find any definition of the term "portable" that is different from the ordinary meaning. We find the ordinary meaning of the term "portable" is best found in the dictionary. We note that the

definition most suitable for "portable" is either "capable of being carried" or "easily carried or moved."[3]

We appreciate Appellant's position that a "portable device" is limited to very small devices such as a cellular phone or a personal digital assistant (Appellant's specification at page 4, line 16). However, we find that the claim language does not preclude reading on Abecassis' multimedia player and Berstis' computers, servers, and components as such devices are "easily moved." We note that Berstis also list a "notebook" computer as one example of a client machine 10 at column, 13, lines 43-48.

Now, the question before us is, what would Berstis have taught to one having ordinary skill in the art? To answer this question, we find the following facts:

(1) Berstis teaches at figure 1, transferring (copying) a digital file from a source device (20) to a target device (10).

(2) Berstis teaches in column 1, at lines 27-33, the source device is a storage device.

(3) Berstis teaches in column 1, at lines 27-33, the target device is either a rendering device or a storage device.

(4) Berstis teaches in column 5, at line 24, the digital file may be an audio file.

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[3] ***Webster's II New Riverside University Dictionary***

(5) Berstis teaches in column 3, at lines 14-24, copy control information including a count of the number of permitted copies.

(6) Berstis teaches in column 6, at lines 59-61, the digital file and part of its copy control information, are transferred between the source device and target device.

(7) Berstis teaches in column 9, at lines 14-15, there may be another digital file storage device before the source device in the file transfer string, "[i]f the file is not present at the source, it may be necessary to obtain it."

(8) Berstis teaches a similar multi-stage transfer to (7) above at figure 4, items 44 and 40 (which comprises items 24 and 26), as discussed in part at column 7, line 64, to column 8, line 35.

(9) Berstis teaches in column 5, at lines 29-31, "copies are controlled throughout the systems and networks until their final rendering place."

(10) Berstis teaches in column 8, at lines 21-26, and column 9, at lines 45-62, client 40 tracks the current count and periodically reports to the management server.

Appellant's argument that, "there is no teaching or suggestion to send a transfer count from a first portable device to a second portable device" is not persuasive. As listed above,

we find that Berstis teaches performing digital audio file transfers between first and second portable devices (facts 1-4) where there is also a transfer of copy control information (fact 6). We note that Berstis is silent as to the specific part of the copy control information that is transferred. However, we find that in the situation where there is copying of a set number of "permitted copies" (fact 5), one of ordinary skill in the art would recognize that the copy tracking (fact 10) of Berstis would be inoperative if the transferred copy control information (fact 6) did not include a count of the number of permitted copies (fact 5). Therefore, Berstis teaches "sending a transfer count from a first portable device to a second portable device."

Appellant's further argument, "nowhere does Berstis (or Abecassis) disclose or suggest, a method in which a music file is transferred to a second portable device from a first portable device" is equally unpersuasive. A person skilled in the art would recognize that Berstis teaches multi-stage file transfers from a first device to a second device and then to a third device (facts 7-10). See for example, Berstis figure 4, the transfer from item 44 (a first portable device) to item 24 (a second portable device), and then to device 26. We find that the combination of Berstis and Abecassis teach a "method in which a

music file is transferred to a second portable device from a first portable device."

Therefore, we will sustain the Examiner's rejection under 35 U.S.C. § 103.

II. Whether the Rejection of Claims 23-24 Under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 23-24. Accordingly, we affirm.

With respect to independent claim 23, Appellant essentially repeats the argument made with respect to claim 10. Appellant argues, "Berstis does not teach or suggest a controller to 'transmit an indication to the remote portable music player indicating the number of times the remote portable music player may transfer the transmitted file' as recited in claim 23." We find this argument unpersuasive for the reasons noted above with respect to claim 10.

Therefore, we will sustain the Examiner's rejection under 35 U.S.C. § 103.

III. Whether the Rejection of Claim 25 Under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 25. Accordingly, we reverse.

With respect to dependent claim 25, Appellant argues at page 12 of the brief, "nowhere does Berstis or Abecassis disclose or suggest transmitting a file to 'a Secure Digital Music Initiative [SDMI] compliant music player' as recited by the claim."

We find that SDMI is a specific standard in the art, and we agree with Appellant that Abecassis and Berstis do not teach or suggest using the SDMI standard. We note that Appellant has admitted that the SDMI standard is a known standard. See Appellant's specification at page 1, lines 17-20. While an argument might be made that an extension of the process of claim 23 using the SDMI standard is obvious in the extreme given Appellant's admission, no such rejection was made by the Examiner. We leave it to the Examiner to decide if a rejection of claim 25 is appropriate under 35 U.S.C. § 103 as being obvious over the combination of Abecassis and Berstis and Appellant's admitted prior art.

Therefore, we will not sustain the Examiner's rejection under 35 U.S.C. § 103.

Other Issues

In Appellant's specification at page 8, lines 2 and 18, and page 9, line 18, "Figure 2" should read "Figure 3."

Conclusion

In view of the foregoing discussion, we have sustained the rejection under 35 U.S.C. § 103 of claims 10-16 and 23-24, and we have not sustained the rejection under 35 U.S.C. § 103 of claim 25.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

LEE E. BARRETT Administrative Patent Judge	)
JOSEPH L. DIXON Administrative Patent Judge	) BOARD OF PATENT APPEALS AND INTERFERENCES
ALLEN R. MACDONALD Administrative Patent Judge	)

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